

83



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,253	11/08/2001	Tomoyuki Ohno	35.C15940	5016
5514	7590	03/23/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			MILIA, MARK R	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2625	
DATE MAILED: 03/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,253

Applicant(s)

OHNO ET AL.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/2/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/24/05 + 12/2/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 12/2/05 and has been entered and made of record. Currently, claims 69-82 are pending.

Drawings

2. Applicant's amendment to Figures 10A, 10B, 12A, 12B, 13A, and 13B to remove reference characters not described in the specification has overcome the objection as cited in the previous Office Action. Therefore the objection has been withdrawn.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 81 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 81 is drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claim 81, while defining a computer-executable program, does not define a "computer-readable medium" and is thus non-statutory for that reasons. A computer-executable program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests canceling claim 81 and amending claim 82 to read, "A computer-readable recording medium which stores a computer-executable program for causing a television broadcasting receiving apparatus to execute the control method set out in claim 75" in order to make the claim statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Response to Arguments

4. Applicant's arguments filed 12/2/05 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding claims 69-82, wherein on pages 11-12, applicant asserts that the reference of Narushima fails to disclose "a display control unit adapted to output, to a display device on the basis of the print additional information analyzed by said analyzing unit, display data associated with the print additional information together with program data associated with the television broadcasting data received by said receiving unit". The examiner respectfully disagrees as the reference of Narushima does disclose such a feature. Particularly, Narushima discloses a digital broadcast signal comprising video, audio, and print control data. As shown in figure 10, all the data received by the receiving unit is displayed on the display and the user is given the option to choose a desired service and to print any desired information of which is viewable by the user. The data being displayed is the data that a user is able to print in addition to, for example, watching a television program. Therefore the reference of Narushima discloses "a display control unit adapted to output, to a display device on the basis of the print additional information analyzed by said analyzing unit, display data associated with the print additional information together with program data associated with the television broadcasting data received by said receiving unit".

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 69-72, 74-78, and 80-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Narushima.

Regarding claims 69, 75, 81, and 82, Narushima discloses a television broadcasting data receiving apparatus, comprising: a receiving unit adapted to receive television broadcasting data which was subjected to multiplexing (see column 4 lines 49-55, column 8 lines 15-20, and column 9 line 21-column 11 line 5), an acquiring unit adapted to acquire print data and program attribute information, included in the television broadcasting data received by said receiving unit (see column 9 line 21-column 11 line 5, column 15 lines 5-36, column 16 line 46-column 17 line 6, and column 21 line 64-column 23 line 35), an analyzing unit adapted to analyze print additional information for printing of the print data, included in the program attribute information acquired by said acquiring unit (see column 9 line 21-column 11 line 5, column 15 lines 5-36, column 16 line 46-column 17 line 6, and column 21 line 64-column 23 line 35), and a display control unit adapted to output, to a display device on the basis of the print additional information analyzed by said analyzing unit, display data associated with the print additional information together with program data associated with the television broadcasting data received by said receiving unit (see Figs. 8, 10, and 17, column 11 lines 19-30, column 12 lines 16-27, column 15 lines 5-36, column 16 line 46-column 17 line 6, column 17 lines 46-51, column 22 line 11-column 23 line 35, and column 28 lines 48-56).

Regarding claims 70 and 76, Narushima further discloses wherein said acquiring unit acquires the program attribute information associated with the program data

Art Unit: 2622

displayed by said display device (see column 9 line 21-column 11 line 5, column 15 lines 5-36, column 16 line 46-column 17 line 6, and column 21 line 64-column 23 line 35).

Regarding claims 71 and 77, Narushima further discloses an accepting unit adapted to accept a printing instruction from a user (see column 13 lines 35-43 and column 15 lines 5-36), and a print controlling unit adapted to control the output of the print data to a print device on the basis of the printing instruction (see column 16 line 46-column 17 line 6 and column 22 line 49-column 23 line 35), wherein said accepting unit accepts the printing instruction from the user in a period during which said display controlling unit effects a display which indicates that printing based on the print additional information is possible (see column 15 lines 5-45 and column 21 line 64-column 23 line 35).

Regarding claims 72 and 78, Narushima further discloses an accepting unit adapted to accept a storing instruction from a user (see column 13 lines 35-43 and column 15 lines 5-36), and a storage controlling unit adapted to store the print data in a storage unit on the basis of the storing instruction (see Figs. 8 and 20 "140" and column 24 line 29-column 25 line 20), wherein said accepting unit accepts the storing instruction from the user in a period during which said display controlling unit effects a display which indicates that storing based on the print additional information is possible (see column 15 lines 5-45 and column 24 line 29-column 25 line 20).

Regarding claims 74 and 80, Narushima further discloses wherein in case that there are a plurality of types of print additional information to be displayed by said

display device, said display controlling unit displays the respective display data associated with the plurality of types of print additional information so that the display of each of the respective display data is switched over therebetween at a predetermined time interval (see Fig. 10, column 13 lines 24-56, and column 15 line 5-column 16 line 45).

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 73 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narushima as applied to claims 69 and 75 above, and further in view of Nabeta.

Narushima does not disclose expressly wherein the print additional information includes information for specifying a transmission period of time of the print data, and wherein said display controlling unit displays a print execution time of the print data on the basis of the transmission period.

Nabeta discloses wherein the print additional information includes information for specifying a transmission period of time of the print data, and wherein said display controlling unit displays a print execution time of the print data on the basis of the transmission period (see abstract and paragraphs [0005], [0006], and [0015]).

Narushima & Nabeta are combinable because they are from the same field of endeavor, displaying and printing of desired information.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the display of the wait time until a print job is complete as described by Nabeta and well known in the art with the system of Narushima.

The suggestion/motivation for doing so would have been to provide a way to inform a user of the time it will take to print a job to alleviate the chance of a user accidentally trying to print an image a plurality of times.

Therefore, it would have been obvious to combine Nabeta with Narushima to obtain the invention as specified in claims 73 and 79.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2622

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
Art Unit 2622

MRM

JOSEPH R. POKRYWA
PRIMARY EXAMINER
ART DIVISION 2625

